OIPE
DEC 18 2007

Doc~~Code~~: PRE.REQ

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) POU920030137US1

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on __December 6, 2007__ Signature__/Stephen Bongini/__ Typed or printed name __Stephen Bongini__	Application Number 10/759,966	Filed 1/16/2004
	First Named Inventor Jordi Albornoz	
	Art Unit 3692	Examiner Clifford B. Madamba

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
　　　　Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number _____40,917_____.

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

/Stephen Bongini/
Signature

Stephen Bongini
Typed or printed name

(561) 989-9811
Telephone number

December 6, 2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: JORDI ALBORNOZ
Serial No.: 10/759,966   Group Art Unit: 3692
Filed: January 16, 2004   Examiner: C. Madamba

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1-20 were rejected under 35 U.S.C. § 102(b) as being anticipated by Ensel et al. (U.S. Patent No. 6,493,685). This rejection is respectfully traversed.

The Ensel reference does not teach each and every element recited in the pending claims. For example, Ensel does not teach the following elements recited in independent claim 1.

> *determining that one of the automatic recurring payments is to be executed based on the automatic recurring online payment configuration;*
>
> *in response to determining that the one automatic recurring payment is to be executed, sending a notification to the user to notify the user that the one automatic recurring payment is to be executed, the notification being sent to the user before the one automatic recurring payment is executed; and*
>
> *determining whether or not to execute the one automatic recurring payment based on at least one of a response to the notification received from the user and a lack of a response to the notification from the user within a specified period of time.*

Independent claims 10 and 17 contain similar recitations.

Ensel merely teaches sending only a bill notification to a user, and not a notification that an automatic recurring payments is to be executed. It is respectfully submitted that the Examiner is mischaracterizing Ensel.

Ensel is directed toward an information interface provider ("IIP") that acts as an interface between a billing entity and its customers. In Ensel, the IIP presents electronic bills to customers and processes payments made by the customers. The customer can select how bills are to be presented and the IIP then transmits the bills through that channel.

The IIP receives the billing data from the billing entity, formats the billing data for storage, and then formats the bill for the desired channel of distribution. With regard to payments, customers can pay in different manners such as by credit card or paper check, and the IIP can also track preauthorized payments of certain bills. For preauthorization of payments, the

customer first authorizes the IIP to recurringly debit a selected account to pay a recurring bill (or bills) that typically is always for the same amount (e.g., a mortgage payment). Once payment has been preauthorized, whenever the preauthorized payment for that bill is due, the IIP debits the selected account and credits the account of the billing entity.

In contrast, the presently claimed invention is directed to an efficient and easy-to-implement method for providing prompted automatic recurring online payments. Instead of immediately executing a payment according to a recurring schedule as taught by Ensel, the presently claimed invention <u>sends a notification to the user before the automatic recurring payment is executed</u>. Then, it is determined whether or not to execute the automatic recurring payment based on a response received from the user and/or a lack of a response from the user within a specified period of time. Because <u>the user is notified before</u> an automatic recurring payment is to be executed, the user can decide whether or not to have the payment executed as previously planned. Thus, the present invention still provides the convenience of having the system automatically remember recurring payments, but allows the user to maintain more control over the payments.

With respect to the elements of claim 1 recited above, the Examiner has taken the position that Ensel teaches:

> examples of the type of information included in the enrollment database includes, but is not limited to ...reminder preferences (e.g., as soon as possible, at the end of the month, 5 days before due date, 5 days late, no reminder...) as well as reminder channels (e.g., email, paper mail, fax, phone call, beeper...)" and in at least column 14, lines 38-41 wherein "the enrollment database can also track unopened bills and generation reminders as specified in the reminder preferences contained in the enrollment database file.

However, these cited portions of Ensel clearly show that <u>Ensel **only** teaches sending a bill notification</u>. Column 10 of Ensel merely states that a user can enter a variety of preferences such as "reminder preferences (e.g., as soon as possible, at end of month, 5 days before due date, on due date, 3 day (sic) late, no reminder....)". Ensel does not indicate that these reminders are associated with automatic recurring payments. In fact, Ensel is only referring to bill reminders that are sent to notify a user that a bill needs to be paid.

Furthermore, the Examiner's remark that Ensel teaches "in at least column 14, lines 38-41 wherein 'the enrollment database can also track unopened bills and generation reminders as specified in the reminder preferences contained in the enrollment database file'" is completely irrelevant with respect to the presently claimed invention. This citation is referring back to the reminder discussed above and is directed at "unopened bills"; it is **not** directed to automatic recurring payment notifications.

The Examiner's response to Appellant's argument that Ensel is directed towards notifying a user of a bill, not of an automatic recurring payment, is that:

> Ensel in at least column 10, lines 43-45 wherein "examples of the type of information included in the enrollment database includes, but is not limited to: ,..payment preferences (e.g., preauthorized, on due date, at end of month, full or fixed amount, automatic within limit)..." This feature is also taught by Ensel in at least column 4, lines 48-51 which indicates that "using preauthorization, the user may authorize the information interface provider to debit a preselected consumer account with respect to certain bills, typically recurring bills for the same amount, e.g., a mortgage payment."

While Ensel does teach that a user can configure payment methods, this is very different from and does not teach or suggest notifying a user that an automatic recurring payment is to be executed. Ensel merely teaches that a user can setup automatic payments. However, Ensel is completely silent on notifying a user that one of these automatic recurring payments is about to be executed. For example, at column 14, lines 54-64, Ensel teaches:

> With respect to payments, the BAP 200 initiates the automatic payments prescribed in the enrollment profiles 205 without any initiative required by the customers 80. ... For both management and customer service purposes, the BAP 200 keeps track of the status of customer payments, i.e., scheduled, in process, disputed, paid, and posted...

Thus, Ensel only teaches that automatic payments are initiated, and is completely silent on determining that an automatic recurring payment is to be executed and notifying the user that the automatic recurring payment is to be executed.

Sending an email containing a bill is very different form sending a notification that notifies the user that an automatic recurring payment is to be executed. The Examiner's response is that "Ensel teaches a notification means not only for bill availability [see at least column 10, lines 36-29] but for recurring payments as well [see at least column 4, lines 48-51]".

However, these portions of Ensel further support Appellant's position that Ensel merely teaches providing a mechanism for processing automatic payments, and not a mechanism for notifying the user that an automatic recurring payment is to be executed. For example, column 4, lines 48-51 of Ensel merely state that a user can authorize the system of Ensel to debit a preselected account to pay a bill. Appellant simply cannot understand how the Examiner can assert that this teaching is the same as sending a notification to a user that an automatic recurring payment is to be executed. The two are completely different. <u>With respect to the present invention, the user is notified of an automatic recurring payment before that automatic recurring payment is executed. This allows the user to confirm, modify, cancel, or otherwise react to the automatic recurring payment before it is made. Ensel does not proved such a feature, and thus cannot possibly allow any such response from the user before the payment is made.</u>

Further, the Examiner asserts that Ensel teaches "determining whether or not to execute the one automatic recurring payment based on at least one of a response to the notification received from the user and a lack of a response to the notification from the user within a specified period of time."

As explained above, Ensel does not teach sending a notification to the user to notify the user that an automatic recurring payment is to be executed before that automatic recurring payment is executed. Therefore, Ensel cannot possibly teach determining whether or not to execute a payment <u>based on a response to such a notification</u> received from the user <u>and/or a lack of a response to such a notification</u> from the user within a specified period of time.

Ensel only teaches presenting bills to a user and paying a bill based on user preauthorization or user payment instructions. In Ensel, automatic payments are always performed without any notifying to the user beforehand. This is very different than sending a notification to the user before an automatic recurring payment is to be executed, and then determining whether or not to execute that automatic recurring payment based on a response and/or lack of a response from the user.

Therefore, Ensel does not teach or suggest each and every element of the presently claimed invention. For example, Ensel does not teach the recited claim elements of *"determining that one of the automatic recurring payments is to be executed based on the automatic recurring*

online payment configuration; in response to determining that the one automatic recurring payment is to be executed, sending a notification to the user to notify the user that the one automatic recurring payment is to be executed, the notification being sent to the user before the one automatic recurring payment is executed; and determining whether or not to execute the one automatic recurring payment based on at least one of a response to the notification received from the user and a lack of a response to the notification from the user within a specified period of time."

Appellant believes that the differences between Ensel and the present invention are clear in independent claims 1, 10, and 17, which set forth various embodiments of the present invention. Further, claims 2-9, claims 11-16, and claims 18-20 depend from independent claims 1, 10, and 17, respectively. Thus, claims 2-9, 11-16, and 18-20 also distinguish over Ensel. Therefore, claims 1-20 distinguish over the Ensel reference, and the rejection of these claims under 35 U.S.C. § 102(b) should be withdrawn

In view of the foregoing, it is respectfully submitted that the application and the claims are in condition for allowance. Reconsideration and allowance of the claims are respectfully requested.

Respectfully submitted,

Date: December 6, 2007

By:___/Stephen Bongini/_____

Stephen Bongini
Reg. No. 40,917
Attorney for Appellant

FLEIT KAIN GIBBONS
GUTMAN BONGINI & BIANCO P.L.
One Boca Commerce Center
551 Northwest 77th Street, Suite 111
Boca Raton, Florida 33487
Telephone: (561) 989-9811
Facsimile: (561) 989-9812